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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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024492 IM52/0319
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UNITED STATES DEPARTMENT OF COMMERCE
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 16

Application Number: 09/121,628
Filing Date: 7/23/98
Appellant(s): Michael Sullivan

Richard Klein
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 11/13/00.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 6/9/00 has not been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

Appellant's brief presents arguments relating to the non entry of amendment B of 6/9/00. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP §§ 1002 and 1201.

(7) Grouping of Claims

The rejection of claims 1-8 and 12-16 on obviousness double patenting grounds stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 1-5,13,14 and 16 as obvious over Nesbitt in view of Horiuchi stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 1-8 and 12-16 as obvious over Nesbitt in view of Horiuchi and Sullivan stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5387470	Parnell	2-1995
5222739	Horiuchi	6-1993
5061757	Warner	10-1991
4884814	Sullivan	12-1989
4431193	Nesbitt	2-1984
4187358	Kyo	2-1980

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 12 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of copending Application No. 8-815556. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-8 and 12-16 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8,12 and 13 of copending Application No. 8-815556. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim 3 layer golf balls with a high acid ionomer inner cover and a low flexural modulus ionomer as the outer cover. The copending application is broader in the sense that ionomer or nonionomer outer covers are claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5,13,14 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over the Nesbitt '193 Patent in view of Horiuchi '739.

Nesbitt discloses golf balls having a hard inner cover and a softer outer cover. A suggested material for the outer cover is Surlyn 1855 (col. 3 line 38). Surlyn 1855 inherently is a zinc ionomer of on ethylene/acrylic acid copolymer having 10% acid (see Warner col. 4 line 53-56). Surlyn 1855 has a flex modulus of 640 kg/cm^2 (table 4-C9 of Kyo) which converts to 9,000 psi.

Nesbitt does not limit himself to any particular ionomer as his inner cover, although surlyn 1605 (col. 3 line 28) is suggested. Surlyn 1605 is a sodium ionomer of ethylene/methacrylic acid copolymer having 15% acid (see Parnell col. 4 line 68). This "15 acid" borders on appellant's "16% acid".

It is known that higher acid ionomers (above 16%) are stiffer, have higher impact resilience, farther flying distance and superior cut resistance (see Horiuchi col. 1 line 55-59).

It would have been obvious to use ionomers having above 16% acid as Nesbitt's inner cover. Nesbitt's inner cover of "hard, high flex modulus "ionomer is intended to provide the maximum coefficient of restitution (ie impact resilience). This is exactly the properties high acid ionomers are known to provide

Use of slightly higher acid based ionomers (16% vs. 15%) in the inner cover would be expected to improve flight distance for the ball.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Nisbitt '193 Patent in view of Horiuchi '739 and Sullivan '814.

Nesbitt does not suggest his outer cover as being a blend of hard and soft ionomer. Blends of hard and soft ionomer are known to provide a balance of distance, spin and durability not obtainable previously (see Sullivan col. 3 lines 38-64).

It would have been obvious to use a blend of hard and soft ionomer as Nesbitt's outer cover for the expected benefits.

(11) Response to Argument

Appellant gives no explanation why the provisional USC 101 rejection is not applicable to claim 12 in its current state.

The amendment of 6/9/00 was denied entry due to the new issue of shore D language which requires further consideration and possibly an additional reference (see MPEP 714.13 "Action By Examiner"). This is not a "new matter" determination.

Appellant argues provisional obviousness double patenting rejections should be withdrawn based on a "promise" to provide a terminal disclaimer at a later date of necessary.

The examiner is unaware of any such PTO policy. In fact, the examiner has previously cited MPEP 804.02 (second to the last paragraph under II "nonstatutory") that requires terminal disclaimers in both applications. Furthermore a terminal disclaimer must be timely filed.

Appellant argues Nesbitt and Horiuchi cannot be combined, because Nesbitt is directed to three layer balls, while Horiuchi is directed to two layer balls.

Of course Horiuchi does not suggest three layer balls. The reference would have been applied anticipatory if such a suggestion was present in the reference.

Arguing the secondary reference is not anticipatory is never convincing against a 103 type rejection.

The examiner relies on Horiuchi to teach the benefits of high acid ionomers. Higher stiffness and higher impact resilience (resulting in better flying performance) is achieved when using ionomers of 16-30% acid. These are precisely the characteristics called for by Nesbitt for his inner layer (col. 1 lines 57-60). Nesbitt does not explicitly teach any acid level in his inner cover ionomer (although inherently 15% is used). One practicing Nesbitt's invention would select ionomers of high flex modulus (ie stiffness) and coefficient of restitution (impact resilience). The recently developed ionomers of 16-30% acid meet this criteria.

It appears appellant is merely "updating" Nesbitt's inventive concept of stiff inner cover (for shot distance) and soft outer cover (for"feel") by replacing the older stiff ionomer with newer stiff ionomer. Only the expected improvements are obtained.

Arguments that claims 2-5, 13 and 14 recite additional aspects not suggested by Nesbitt/Horiuchi are clearly false.

Nesbitt claims (#4-6) thicknesses and diameters that overlap appellant's ranges. Nesbitt's outer cover of surlyn 1855 has been proven to have a modulus of 9,000 psi. Horiuchi's table 1 exemplifies high acid ionomers with the proper acid content and modulus.

Appellant argues Sullivan is limited to two layer balls while Nesbitt is directed to three layer balls.

Appellant fails to provide any reasoning why the advantages of Sullivan's hard/soft ionomer blend would not be expected to manifest themselves on a three layer ball such as the Nesbitt ball. Sullivan teaches an outer cover of a hard/soft ionomer blend results in a soft cover that a skilled golfer can impart backspin to (abstract). These are the qualities Nesbitt desires in his outer cover.

The evidence of commercial success is not convincing. The Newspaper Article, advertisements etc. submitted do not completely identify what the Strata ball is made of. Appellant's claims encompass many materials. The claims could not possibly be commensurate in scope with the showing. The outer cover is said to be Balata in the submitted articles/advertisements. The current claims do not call for Balata in the outer cover.

What type of core is used? What metal is used in the ionomer? To what degree neutralized? All these factors contribute to the properties of the ball. The claims are not limited to the commercial strata ball (whatever the commercial ball is actually made of). The articles do not indicate the strata ball is any different than the ball of Nesbitt '193.

Appellant has not met the burden set out in MPEP 716.03-716.036.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

David B Buttner

DAVID J. BUTTNER
PRIMARY EXAMINER

Buttner/af
March 16, 2001

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